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EXAMINER
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SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/294,461  
Filing Date: April 19, 1999  
Appellant(s): SHANMAN ET AL.

Paper No. 26

Bruce L. Adams  
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

Pursuant to the "Remand to Examiner" under 37 CFR  
1.193(b) (1) by the Board of Patent Appeals and Interferences on  
August 17, 2004, a supplemental Examiner's Answer is set forth  
below.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

Appellants' amendment D after final filed with a certificate of mailing dated November 1, 2002, canceling claims 1-8, 11-13, and 25-28, has been entered. Claims 29-40 remain pending and are on appeal.

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**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 29-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

"Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS"; PRNewswire, p106NYM035; 06 January 1997.

"EXCITE Reports First Quarter 1999 Results"; PRNewswire, SFTH077; 15 April 1999.

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5,848,399	BURKE	12-1998
6,014,634	SCROGGIE et al.	01-2000
6,055,513	KATZ et al.	04-2000

**(10) Grounds of Rejection**

The following grounds of rejection are reformulated presentations of the previous grounds for rejections set forth in the final Office action, mailed July 1, 2002 (Paper No. 13). These reformulated presentations are consistent with rejection guidelines set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j) and §§ 2141-2144.09 (8th ed., Rev. 2, May 2004).

Authorization for such action by Supplemental Examiner's Answer has been given pursuant to 37 CFR § 1.193(b)(1)(2003) by the Board of Appeals and Interferences in it's "Remand to Examiner", mailed August 17, 2004 (Paper No. 25).

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 30, and 32-40 are rejected under 35 U.S.C.

103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS"; PRNewswire, p106NYM035; 06 January 1997 (hereafter "ZIP COUPONS") in view of "EXCITE Reports First Quarter 1999 Results"; PRNewswire, SFTH077; 15 April 1999 (hereafter "EXCITE"); Scroggie et al. (U.S. Patent No. 6,014,634); and Burke (U.S. Patent No. 5,848,399).

Claims 29, 37 and 40

ZIP COUPONS (at pg. 1, para. 2) discloses:

a plurality of consumer units operated by a consumer;  
communications means connectable over a communication medium to at least a coupon server;

a user input device to permit a consumer to make one or more choices displayed on the display monitor;

a coupon server located remotely from the consumer units, comprising:

a memory for storing first data corresponding to one or more participating retail outlets including data for

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identifying each of the retail outlets by name and inventory of goods offered for sale, and second data containing coupon data used for generating electronic discount coupons for selected goods;

a data processing unit having communication means connectable over the communication medium to the consumer units;

first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first rule containing a list of participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit (e.g. *through the selection of the types of coupons that the consumer is interested in, and display of available coupons and the associated merchants identified with the coupons*);

second means responsive to the selection of a retail outlets displayed on the display monitor of the respective consumer unit by the consumer to transmit to the respective consumer unit a second file containing first data corresponding to the selected retail outlet for display on the display monitor of the consumer unit, the second file containing the identity of goods offered for sale by the



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selected retail outlet, and the displayed goods being individually selected by the consumer using the user input device (e.g. *as illustrated through the representation and selection of the coupons*); and

third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the consumer unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods (e.g. *through the selection of coupons for desired products/services, the consumer is selecting products/services for purchase*).

ZIP COUPONS disclose that advertisers will pay Internet Infinity, Inc for placement of their ZIP COUPONS on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of the participating retail outlets are displayed on the display monitor of the consumer unit.

ZIP COUPONS, however, does not explicitly show that the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed

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retail outlets transmitting a list of goods for which discounts are available. Nonetheless, this is inferred from the disclosure of ZIP COUPONS, as shown above, as the consumer selects the coupons for products that the consumer wants to obtain, and the coupons are provided to the consumer. Official Notice is taken that the consumer may base his choices on any one or more of many parameters, such as cost, size, color, etc. of the choices, as well as, the particular merchant providing the coupon redemption service that sells the products of choice. In this way, the consumer selects the merchant that he prefers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified ZIP COUPONS such that the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available, because this is only an obvious variation of ZIP COUPON that results from a slightly different, yet obvious, sorting of the same database of available goods and coupons. Thus, when coupons are selected for each of the participating stores as disclosed in ZIP COUPONS, products and retail stores are being individually selected by the consumer.

Further to this, EXCITE discloses that consumers are able to access digital redeemable coupons from participating online

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merchants, all personalized based on an individual's shopping interests (pg. 2 3rd para.), as may be portrayed by a shopping list. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified ZIP COUPONS to have included a list of participating retail outlets in such a manner that the retail outlets are individually selectable by the consumer and transmitting a list of goods for which discount coupons are available in order for the individual to view and select products available from the retail outlet, as taught by EXCITE, because this would have thereby simplified the consumer's selection procedures for goods and retail outlets. When coupons are selected for each of the participating stores as taught by ZIP COUPONS and EXCITE, simultaneously, products and retail stores are individually selected by the consumer.

Additionally, Scroggie discloses:

using a first computer operated by a consumer to establish a connection with a second computer over a communication medium (col. 1, lines 47-64);

using a second computer to acquire identifying indicia for identifying the geographical location of the first computer (col. 1, lines 52-61);

selecting from a list of participating retail outlets stored in the second computer one or more participating retail

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outlets in the geographical vicinity of the first computer (col. 1, line 47-col. 2, line 17);

disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1, lines 56-64);

the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region (col. 1 lines 56-64); and

receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64).

An important element of the Scroggie invention is that it permits the customer to plan his or her shopping and shopping-related activities more efficiently. To this end, Scroggie also

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includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons. In one aspect of the Scroggie invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 8-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of ZIP COUPONS and EXCITE to have included displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet (as taught by Scroggie et al.), because this provides desirable and well known capabilities to the consumer/shopper and may influence the shopping habits of the consumer/shopper at the selected retail outlet or store.

The combination of ZIP COUPONS, EXCITE, and Scroggie et al. does not teach that the second file contains graphical data for

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displaying a representation of the physical layout of the goods in the selected retail outlet.

Burke, however, teaches an output of the retail space management system (52) is a three-dimensional description (56) of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description (56) includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description (56) can be stored in a store database (61), accessible by an indication of the store (59) which it describes (col. 4 lines 58-67; col. 5 lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of ZIP COUPONS, EXCITE, and Scroggie et al. to have included data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale (as taught by Burke), because this enhances the invention's desirability to consumers through the

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ease of locating desired products in a store and may enhance customer attraction to the merchant.

Claim 30

ZIP COUPONS discloses means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto; selecting one or more participating retail outlets in the vicinity of the consumer unit; and downloading for display on the display monitor of the consumer unit the first file containing a list of the selected retail outlets (pg. 1 para. 2: *e.g. customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, etc.*).

Claim 32

ZIP COUPONS discloses means for transmitting a file to the consumer unit containing a form requesting the consumer to identify the geographical location of the consumer unit (pg. 1 para. 2: *e.g. where customers select the U.S. Postal zip code area where they want to shop*).

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Claim 33

ZIP COUPONS discloses a hardcopy apparatus for producing a hardcopy of electronic coupons transmitted to the consumer unit (pg. 1 para. 2: *e.g. as inferred by the capability where the customer can print out the desired coupons*).

Claim 34

ZIP COUPONS discloses a printer connected to a consumer unit (pg. 1 para. 2: *as inferred by the capability where the customer can print out the desired coupons*).

Claim 35

The combination of ZIP COUPONS, EXCITE, Scroggie et al., and Burke does not explicitly provide a point-of-sale unit located in a participating retail outlet, or a hardcopy apparatus.

However, Official Notice is taken that it was old and well known at the time the invention was made that user stations or terminals for consumers' use were made available at participating retail outlets (e.g. in kiosks). Here, consumers may search for information on goods and products sold by the participating retail outlet and print coupons, as desired.



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Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that a computer typically comprises a display monitor; a memory for storing data to be displayed on the display monitor; a data processing unit; a hardcopy apparatus; a user input device; or any additional devices that are considered necessary for the very basic operation of the computer in a particular manner.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined ZIP COUPONS, EXCITE, Scroggie et al., and Burke with such old and well known computer devices to have resulted in a point of sale unit comprising a hardcopy apparatus; a display monitor; a memory for storing data to be displayed on the display monitor; a data processing unit; a hardcopy apparatus; and a user input device, because such configuration would have provided the very basic functionality that is necessary for such combination to operate.

Claim 36

The combination of ZIP COUPONS, EXCITE, Scroggie et al., and Burke thus provided teaches:

the coupon server is located remotely from the point-of-sale unit (pg. 1 para. 2), and further comprises:

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means for transmitting to the point-of-sale unit a fourth file containing the identity of coupons for goods offered for sale by the retail outlet at which the point-of-sale unit is located (pg. 1 para. 2); which implies that goods for sale are identified by the list of coupons available.

The combination does not explicitly provide that the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods. However, ZIP COUPONS does disclose the user selecting a postal ZIP code area where they want to shop (i.e., which can be remote from the coupon server), selecting coupons to be provided to the user from a displayed list of coupons for a coupon interest category selected by and displayed to the user, for goods that the user is interested in purchasing (pg. 1 para. 2). Further, EXCITE discloses *enables consumer access to valuable promotional offers matched to their shopping interests* (pg. 2 3rd para.), i.e., products that the consumer is interested in.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have

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provided the combination of ZIP COUPONS, EXCITE, Scroggie et al., and Burke to have included that the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, because this would have provided the user with the coupons provided by selected merchants for the purchase of their products, thus encouraging shopping at their establishments.

Claim 38

ZIP COUPONS discloses that one or more consumer units comprise client computers on a network (pg. 1 para. 2).

Claim 39

ZIP COUPONS discloses that the coupon server comprises an Internet host computer (pg. 1 para. 2).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS"; PRNewswire,

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p106NYM035; 06 January 1997 (hereafter "ZIP COUPONS") in view of "EXCITE Reports First Quarter 1999 Results"; PRNewswire, SFTH077; 15 April 1999 (hereafter "EXCITE"); Scroggie et al. (U.S. Patent No. 6,014,634); Burke (U.S. Patent No. 5,848,399), as applied to claim 30, and further in view of Katz et al. (U.S. Patent No. 6,055,513).

Claim 31

ZIP COUPONS discloses that the communication medium comprises a public telephone network (col. 8 lines 2-7). However, the combination of ZIP COUPONS, EXCITE, Scroggie et al., and Burke does not provide means for acquiring caller ID data to identify the geographical location of the consumer unit.

Katz et al., however, teaches:

the communication medium comprises a public telephone network (col. 15 lines 38-65), and

means for acquiring caller ID data to identify the geographical location of the consumer unit (col. 16 lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of ZIP COUPONS, EXCITE, Scroggie et al., and Burke to have included the communication medium comprises a public telephone network; and means for acquiring caller ID data to

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identify the geographical location of the consumer unit (as taught by Katz et al.), because this capability provides obvious and useful enhancements to the invention for the expeditious identification of callers.

**(11) Response to Argument**

Responses to Appellants arguments presented in the Appeal Brief filed February 10, 2003 (Paper No. 19) have been provided in the Examiner's Answer mailed April 21, 2003 (Paper No. 20). Such Responses are incorporated herein by reference.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Smith".

Jeffrey A. Smith  
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